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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,164	01/22/2002	Kevin J. Knight	24544.01	6168
7590 06/23/2009				
R. Lewis Gable Cowan, Liebowitz & Latman, P.C. 1133 Avenue of the Americas New York, NY 10036-6799			EXAMINER COULTER, KENNETH R	
			ART UNIT 2454	PAPER NUMBER
			MAIL DATE 06/23/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/054,164

**Applicant(s)**

KNIGHT, KEVIN J.

**Examiner**

Kenneth R. Coulter

**Art Unit**

2454

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 65-99, 182-247, 249, 250 and 252-338 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 65-99, 182-247, 249, 250 and 252-338 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

Claim 89 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 89 (dependent upon claim 84) is an identical duplicate of claim 84.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 90 – 94 are rejected under 35 USC 112 second paragraph.

Claim 90 recites the limitation "the first image database" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claims 228 and 231 – 235 are rejected under 35 USC 112 second paragraph.

Claim 228 recites the limitations "the first webpage" in line 2; "the set of first images" in line 3. There is insufficient antecedent basis for these limitations in the claim.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 65 – 99, 182 – 247, 249, 250, and 252 – 338 are rejected under 35 U.S.C. 102(e) as being disclosed by Berger et al. (U.S. Pat. No. 6,414,693) (System and Method for Generating Computer Displays of Custom Bag Designs).

2.1 Regarding claim 65, Berger discloses a method for generating a composite image including:

presenting a first image via a Web interface presented on a browser (Abstract; Figs. 1, 3; col. 1, line 66 – col. 2, line 20; col. 3, lines 40 – 52);

presenting a second image via a Web interface presented on the browser (Abstract "Each client is associated with one or more profile, and each profile includes a **series of images** associated therewith"; Figs. 1, 2, 3, 4; Fig. 6, item 608; col. 4, lines 6 – 25; col. 1, line 66 – col. 2, line 20);

communicating a selecting of the first image and the second image to a server via a network (Abstract "selects desired article images"; Fig. 3; col. 2, lines 14 – 20);

automatically generating a composite image of the first image and the second image at the server (Abstract; Fig. 3; col. 2, lines 14 – 24); and

communicating the composite image from the server to the browser via the network (Abstract; Figs. 1, 3, 7; col. 2, lines 14 – 26).

2.2 Per claim 66, Berger teaches that the first image is a product image (Title "Custom **Bag** Designs"; Abstract; Figs. 1, 3, 7; col. 1, line 66 – col. 2, line 20; col. 3, lines 40 – 52).

2.3 Regarding claim 67, Berger discloses that the second image is a decorative image including any one of a group of images including logo image and a text image (Abstract "Each client is associated with one or more profile, and each profile includes a **series of images** associated therewith"; Figs. 1, 2, 3, 4; Fig. 6, item 608; col. 4, lines 6 – 25; col. 2, lines 24 – 28 "while the graphics are **logos**, tradenames, **pictographs**, etc.").

2.4 Per claim 68, Berger teaches that the composite image includes the second image placed in a default position on the first image (Fig. 9; col. 7, lines 44 – 46 "the graphic 802 has been positioned within the relative center of the bag 702").

2.5 Regarding claim 69, Berger discloses:

positioning the second image relative to the first image via a Web interface presented on the browser to generate relative positioning information (Fig. 9; col. 7, line 44 – col. 8, line 20);

communicating the relative positioning information to the server via the network (Fig. 9; col. 7, line 44 – col. 8, line 20); and

automatically generating the composite image of the first image and the second image at the server according to the relative positioning information (Fig. 9; col. 7, line 44 – col. 8, line 20).

2.6 Per claim 70, Berger teaches that the composite image is associated with information in a database, the associated information in the database being communicated together with the composite image from the server to the browser via the network as a photo sample (col. 6, line 48 – col. 7, line 15 “JPEG-format file”; col. 2, lines 24 – 28 “while the graphics are logos, tradenames, **pictographs, etc.**”).

2.7 Regarding claims 71 and 72, Berger does not explicitly disclose that the photo sample is sent via network to a specified email address; or teach a URL, containing the photo sample that is sent via network to a specified email address.

It would have been inherent to implement the sending of photo information via email because Berger clearly discloses an Internet based system (col. 1, lines 6 – 9) for

downloading and uploading information through a browser. Email attachments are notoriously well known avenues for delivery of photo information over the Internet.

2.8 Regarding claims 73 – 99, 182 – 247, 249, 250, and 252 – 338, the rejection of claims 65 – 72 under 35 USC 102(e) (paragraphs 2.1 – 2.7 above) applies fully.

In addition Berger discloses normalizing dimensions of images (col. 6, line 48 – col. 7, line 15).

Also, Berger teaches two separate memory storage areas (libraries) for storage of the superimposed data (Fig. 1, items 130, 122; col. 3, lines 38 – 58).

In addition, Berger discloses first and second parameters that define particular colors for first and second images (col. 8, lines 20 – 42 “enables end users to view completed bags with desired graphics thereon quickly, easily and in **a large number of variations.**” “applications that allow certain portions of the graphic to be in-filled with **alternate colors** ...”; col. 7, lines 9 – 18 “color combinations”).

3. Claims 65 – 99, 182 – 247, 249, 250, and 252 – 338 are rejected under 35 U.S.C. 102(e) as being disclosed by Bornstein (U.S. Pat. No. 6,144,388) (Process For Displaying Articles of Clothing on an Image of a Person).

3.1 Regarding claim 65, Bornstein discloses a method for generating a composite image including:

presenting a first image via a Web interface presented on a browser (Fig. 4; col. 16, line 55 – col. 17, line 25);

presenting a second image via a Web interface presented on the browser (Fig. 4; col. 16, line 55 – col. 17, line 25);

communicating a selecting of the first image and the second image to a server via a network (Fig. 4; col. 16, line 55 – col. 17, line 25);

automatically generating a composite image of the first image and the second image at the server (Figs. 4 and 6B; col. 16, line 55 – col. 17, line 25); and

communicating the composite image from the server to the browser via the network (Fig. 4; col. 16, line 55 – col. 17, line 25).

3.2 Per claim 66, Bornstein teaches that the first image is a product image (col. 16, line 61 – col. 17, line 5).

3.3 Regarding claim 67, Bornstein discloses that the second image is a decorative image including any one of a group of images including logo image and a text image (col. 14, line 39 “text objects”).

3.4 Per claim 68, Bornstein teaches that the composite image includes the second image placed in a default position on the first image (Fig. 10A; col. 26, lines 3 - 10).

3.5 Regarding claim 69, Bornstein discloses:



positioning the second image relative to the first image via a Web interface presented on the browser to generate relative positioning information (col. 19, lines 46 - 58);

communicating the relative positioning information to the server via the network (col. 19, lines 46 - 58); and

automatically generating the composite image of the first image and the second image at the server according to the relative positioning information (col. 19, lines 46 - 58).

3.6 Per claim 70, Bornstein teaches that the composite image is associated with information in a database, the associated information in the database being communicated together with the composite image from the server to the browser via the network as a photo sample (Figs. 1, 4; col. 1, lines 19 – 20; col. 17, lines 27 – 32 and 55 - 59).

3.7 Regarding claims 71 and 72, Bornstein does not explicitly disclose that the photo sample is sent via network to a specified email address; or teach a URL, containing the photo sample that is sent via network to a specified email address.

It would have been inherent to implement the sending of photo information via email because Bornstein clearly discloses an Internet based system (Fig. 4) for downloading and uploading information through a browser. Email attachments are notoriously well known avenues for delivery of photo information over the Internet.

3.8 Regarding claims 73 – 99, 182 – 247, 249, 250, and 252 – 338, the rejection of claims 65 – 72 under 35 USC 102(e) (paragraphs 3.1 – 3.7 above) applies fully.

In addition Bornstein discloses normalizing dimensions of images (col. 19, lines 46 - 58).

Also, Bornstein teaches two separate memory storage areas (libraries) for storage of the superimposed data (Fig. 4, items 114 and 116; col. 16, lines 55 – 64 “models database”; col. 17, lines 19 – 39 “user’s picture database”).

In addition, Bornstein discloses first and second parameters that define particular colors for first and second images (col. 22, lines 11 – 21).

### ***Response to Arguments***

No new arguments were filed on 4/13/09.

Applicant's arguments filed 6/11/07 have been fully considered but they are not persuasive (see non-final rejection mailed on 4/15/08 for responses to these arguments).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Jois et al. U.S. Pat. No. 6,112,242 System and Method for Dynamic Data  
Interaction in a Hypertext Data Processing System

A composite Web page (Abstract) made up of plural sub-pages (Abstract), including  
logos (Fig. 4).

Okimoto et al. U.S. Pat. Pub. No. 2002/0101599 Print System for Executing  
Printing Operations Based on Macros Selectively Designated on Document Set Basis  
An image forming device with overlay image data including overlay image logos  
(paragraphs 40, 45, 46).

Okimoto et al. U.S. Pat. No. 6,552,814  
Related to Okimoto Patent Publication above.

Any inquiry concerning this communication or earlier communications from the  
examiner should be directed to Kenneth R. Coulter whose telephone number is 571  
272-3879. The examiner can normally be reached on M - F, 7:30 am - 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
supervisor, Nathan J. Flynn can be reached on 571 272-1915. The fax phone number  
for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kenneth R Coulter/  
Primary Examiner, Art Unit 2454

/KRC/